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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/002,594	11/20/2001	Mark A. Torrance	01-654	1648

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EXAMINER

LUONG, VINH

ART UNIT	PAPER NUMBER
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3682

DATE MAILED: 03/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/002,594

Applicant(s)

TORRANCE ET AL.

Examiner

Vinh T Luong

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 February 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 and 13-15 is/are rejected.
- 7) ☒ Claim(s) 12 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.


Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 November 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.


Vinh T. Luong
Primary Examiner

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: Exhibit

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1. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

2. The abstract of the disclosure is objected to because of the implied phrase "The present invention relates to . . ." Correction is required. See MPEP § 608.01(b).

3. The drawings are objected to because:

(A) Each part of the invention, such as, the brazing material in claim 12 should be designated by a referential numeral or character; and

(B) The drawings should show the plane 3-3 upon which the sectional view in Fig. 3 is taken.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

4. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the claimed feature(s), such as, the brazing material in claim 12 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

5. The disclosure is objected to because of the following informalities:

(A) Each part of the invention, such as, the brazing material in claim 12 should be designated by a referential numeral or character; and

(B) The Brief Description of the Drawings should describe the plane 3-3 upon which the sectional view in Fig. 3 is taken.

Appropriate correction is required.

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1, 2, 5, 6, 10, 11, 13, and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Beckershoff (US Patent No. 3,986,779).

Regarding claim 1, Beckershoff teaches an assembly for preventing rotation of a damper 7' in a stator system (Figs. 1-3, see Exhibit) comprising: a slot 7' (Fig. 1) in said damper 7'; and a block 7'' for engaging said slot and thereby preventing said rotation of said damper 7'. *Ibid.*, line 31 *et seq.*, and claims 6-14.

Regarding claim 2, said stator system (Fig. 1) including an inner air seal (Exh.); and said block 7'' being located in a groove 2 in said inner air seal (Exh.). The process limitation, such as, "*machined*" is not accorded patentable weight in product-by-process claim. It is well settled that

the patentability of a product does not depend on its method of production. *In re Thorpe*, 227 USPQ 964, 966 (CAFC 1985); *In re Brown*, 173 USPQ 685 (CCPA 1972); *In re Fessmann*, 180 USPQ 324 (CCPA 1974); *Ex parte Edwards*, 231 USPQ 981 (BPAI 1986); and MPEP 2113.

Regarding claim 5, said block 7" has side portions 8 and said groove 2 has side edges (at 4 in Fig. 1). The process limitation, such as, "said side portions of said block are *brazed* to said side edges of said groove 2" is not accorded patentable weight in product-by-process claim. *In re Thorpe*; *In re Brown*; *In re Fessmann*; *Ex parte Edwards*; and MPEP 2113 *supra*.

Regarding claim 6, said block 7" has a substantially rectangular cross section (Exh.) and two chamfered edges 8 (Exh.) for facilitating placement of said block 7" within said groove 2.

Regarding claim 10, Beckershoff teaches a stator system for use in an engine comprising:

- a stator 1;
- an inner air seal (Exh.);
- a damper 7' positioned between said inner air seal (Exh.) and said stator 1;
- said damper 7' having a slot 7'; and
- a block 7" for engaging said slot 7' in said damper 7' so as to prevent rotation of said damper 7' during engine operation. *Ibid.*, line 64 *et seq.*, column 4.

Regarding claim 11, Beckershoff's stator system further comprises a groove 2 machined in said inner air seal (Exh.), and said block 7" is positioned within said groove 2.

Regarding claim 13, said block 7" has two chamfered edges 8 to allow said block 7" to be positioned within said groove 2.

Regarding claim 14, said damper comprises a spring damper. *Ibid.*, line 32 *et seq.*, column 4.

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8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

10. Claims 3, 4, 7-9, and 15, are rejected under 35 U.S.C. 103(a) as being unpatentable over Beckershoff.

Regarding claims 3 and 15, Beckershoff teaches the invention substantially as claimed. However, Beckershoff does not explicitly teach to locate said block at a midspan of the inner air seal.

It is common knowledge in the art to rearrange Beckershoff's block at the midspan of the inner air seal in order to yield a good locking action performance of Beckershoff's stator system. See Beckershoff's Summary of the Invention and legal precedents regarding rearrangement of parts in MPEP 2144.04. See also Judge Clevenger's statement about motivation to combine in *National Steel Car, Ltd. v. Canadian Pacific Railway, Ltd.*, Fed. Cir., No. 03-1256, 1/29/2004.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to rearrange Beckershoff's block at the midspan of the inner air seal in order

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to yield a good locking action performance of Beckershoff's stator system as taught or suggested by common knowledge in the art.

Regarding claim 4, Beckershoff teaches the invention substantially as claimed. However, Beckershoff does not teach the dimension, such as, "said block has a height and said groove has a depth which is from about 50 to 65% of said block height."

It is common knowledge in the art to make Beckershoff's block having the dimensions as claimed in order to yield a good locking action performance of Beckershoff's stator system. See Beckershoff's Summary of the Invention and legal precedents regarding changes in size/proportion in MPEP 2144.04. See also Judge Clevenger's statement about motivation to combine in *National Steel Car, Ltd. v. Canadian Pacific Railway, Ltd.*, *supra*.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to make Beckershoff's block having the dimensions as claimed in order to yield a good locking action performance of Beckershoff's stator system as taught or suggested by common knowledge in the art.

Regarding claims 7 and 8, Beckershoff teaches the invention substantially as claimed. Further, Beckershoff teaches the well-known metal material and non-metal material (heat-resistant material) for the fastening or securing devices, such as, Beckershoff's block. *Ibid.*, line 62, column 1 through line 5, column 2. See also *In re Leshin*, 125 USPQ 416 (CCPA 1960) and MPEP 2144.07.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to make Beckershoff's block of metal or non-metal material in order to yield

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a good locking action performance of Beckershoff's stator system as taught or suggested by Beckershoff.

Regarding claim 9, Beckershoff teaches the invention substantially as claimed. Further, Beckershoff teaches the groove having substantially planar side walls joined by rounded edge portions in his embodiments of Figs. 8-12 in order to yield a good locking action performance.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to round the edge portions of Beckershoff's grooves in his embodiment of Figs. 1-3 in order to yield a good locking action performance of Beckershoff's stator system as taught or suggested by Beckershoff's embodiments of Figs. 8-12.

11. Claim 12 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

12. As allowable subject matter has been indicated, applicant's reply must either comply with all formal requirements or specifically traverse each requirement not complied with. See 37 CFR 1.111(b) and MPEP § 707.07(a).

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: US Patent # 3,736,811 issued to Neary (see slot 35, 53, etc.), US Patent # 5,100,292 issued to Matula et al. (see slot 46), US Patent # 5,240,375 issued to Wayte (damper 40), US Patent # 6,354,803 B1 issued to Grover et al. (damper 50), US Patent No. 4,480,957 issued to Patel et al. (damper 62 in Fig. 8), and Japanese Utility Model # 2-153203 (slot 38 in Fig. 4).

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14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vinh T Luong whose telephone number is 703-308-3221. The examiner can normally be reached on Tuesday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bucci can be reached on 703-308-3668. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Luong

March 5, 2004



Vinh T. Luong
Primary Examiner

EXHIBIT